



Patent Dept.
EXELIXIS, Inc.
P.O. Box 511, 170 Harbor Way
South San Francisco, CA 94083-0511

28 SEP 2006

In re Application of :
Tai et al. :
Application No.: 10/523,706 :
PCT No.: PCT/US03/24561 :
Int. Filing Date: 06 August 2003 : DECISION
Priority Date: 07 August 2002 :
Attorney Docket No.: MBHB05-981-G (EX03-059C-PC) :
For: PSMCs As Modifiers Of The RB :
Pathway And Methods Of Use :

This is a decision on the correspondence filed on 08 August 2006, which is being treated as a renewed request to correct inventorship under 37 CFR 1.497(d).

DISCUSSION

In a decision mailed on 14 June 2006, the declaration of the inventors filed on 21 March 2005 was treated under 37 CFR 1.497(d), in view of the correspondence filed on 28 November 2005. The declaration was not accepted, without prejudice, because

Regarding requirement (3), the "Consent of Assignee" document included among the instant correspondence is signed on behalf of Exelixis, Inc. by Pamela A. Simonton, who states that she is "Senior Vice President, Patents and Licensing of Exelixis, Inc.," and that she has "the authority to act on behalf of the assignee, Exelixis, Inc., in the specific matter of consent to correct inventorship of the instant application." The "Consent of Assignee" further states that "Exelixis, Inc. consents to the addition of Kim Lickteig as an inventor of the instant application." Applicants have also provided a copy of an Assignment document executed in favor of Exelixis, Inc. By Albert K. Tai, Chunyan Song, Michael Martin Ollmann, Lucile A. Gillett, Joanne I. Adamkewicz and Kim Lickteig. Also, insofar as the assignment copy presented appears to have been assembled from individual sheets of one or more separate documents (that is, applicants have not presented complete copies of the document or documents as actually signed), it is not clear whether inventors Adamkewicz and Lickteig signed a complete copy or copies of the document. Therefore, it would not be appropriate to conclude that requirement (3), and the requirements of 37 CFR 3.73(b), have been satisfied, based on the totality of the evidence of record.

Inspection of the declaration filed on 21 March 2005 reveals that it also appears to have been assembled by aggregating individual sheets signed by each of the inventors into a single document. Since counsel has not provided copies of the complete declaration documents signed by each inventor, it is not clear that each inventor had the benefit of signing a complete copy of the declaration document. Therefore, it would not be appropriate to grant the requested relief at this time.

The instant renewed submission references the reel and frame where the assignment of this application is recorded in the USPTO; as such, requirement (3) *supra* has now been satisfied.

Regarding the declaration document filed on 21 March 2005, counsel argues that

Applicants respectfully submit that the declaration filed on March 21, 2005, complies with the requirements of 37 C.F.R. § 1.497(a), 37 C.F.R. § 1.66 and 37 C.F.R. § 1.68. It is the routine business practice of Exelixis, Inc., to provide each named inventor of a utility or design patent application with a complete copy of a declaration naming all of the inventors under 37 C.F.R. § 1.66. Based on the normal business practice of Exelixis, Inc., each named inventor in the above-referenced application reviewed all the of pages of the declaration listing each named inventor, as filed on March 21, prior to signing it. There is no requirement to submit to the U.S.P.T.O. all of the duplicative pages from every declaration sent to all of the inventors.

Counsel's suggestion that "composite" declarations are permissible is without merit. Counsel's attention is drawn to MPEP 201.03, which explains in part that

While each inventor need not execute the same declaration, each oath or declaration executed must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

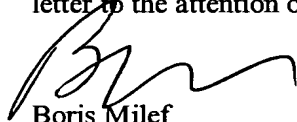
Accordingly, the previously submitted composite declaration will not be accepted.

CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED**, without prejudice.

Applicants are required to submit a complete oath or declaration in compliance with 37 CFR 1.497(a) and (b) within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)." No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration



George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459